

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Salim G. Kara

Application No.: 09/491,949

Confirmation No.: 9277

Filed: January 26, 2000

Art Unit: 3628

For: SYSTEM AND METHOD FOR PRINTING
MULTIPLE POSTAGE INDICIA

Examiner: T. A. Dixon

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Applicant requests review of the Office Action dated November 27, 2006 (hereinafter Office Action) in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

REASONS FOR REQUESTED PRE-APPEAL REVIEW

I. Issues

Claims 1, 3, 4, 7, 11, 14, 15 and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,010,156 to Block (hereinafter *Block*). The Office Action indicates that claims 7, 11, 14, 15 and 16 would be allowable if the Appellant overcomes the 35 U.S.C. § 112 rejections. Appellant hereby traverses the rejections of record and requests the review panel reverse the rejections and allow the claims.

II. Rejections under 35 U.S.C. § 112

The Examiner rejected claims 1, 3, 4, 7, 11, 14, 15 and 16 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Office Action page 2. Appellant notes that the subject matter of the claims need not be described literally (i.e., using the same terms) in order for the disclosure to satisfy the description requirement, see M.P.E.P. § 2163.02. Accordingly, Appellant respectfully asserts the claims meet the written description requirement.

Claims 1, 7, 11, 14, 15 and 16 recite “substantially simultaneously print a plurality of postage meter stamps on said sheet” The Examiner states the phrase “substantially simultaneously” is not supported by the specification. Office Action page 2. However, the claims’ limitation is described in the specification in such a way as to show the inventor had possession of the invention at the time it was filed. For example page 6, lines 4-6 disclose a printer creating a document and an associated return document, as well as the postage to mail *both* documents during one pass across a blank writing medium. In another example, page 13, lines 1-10 of the specification explains printed label 1801 may include two postage indicia, one outbound and one inbound, and be “kiss cut” in order to provide for the printing of two indicia on the same label. In yet another example, page 13, line 14 – page 14, line 4 disclose a single document on which a plurality of postage meter stamps are printed in a single printing operation as shown in FIGURE 21. Accordingly, because the specification discloses a plurality of postage stamps being printed in a single printing operation, the claims reciting “substantially simultaneously print a plurality of postage meter stamps” are supported by the specification, and Appellant requests the rejections be reversed.

Claim 3 recites “stamps includes a date by which an item bearing said postage meter stamp must be posted.” The Examiner argues the limitation is not supported by the specification. Office Action page 2. However, page 14, lines 11-13 of the specification describes a postage indicia including information such as “a date on or before which the item must be posted in order for the indicia to be considered valid.” Accordingly, because claim 3 is supported by the specification, Appellant requests the rejection of claim 3 be reversed.

Claim 4 recites “stamps includes a location from which an item bearing said postage meter is to be posted.” The Examiner argues the limitation is not supported by the

specification. Office Action pages 2-3. However, page 14, lines 11-16 of the specification describe a postage indicia including information such as “the location from which the return mail is to be sent in order for the indicia to be considered valid.” Accordingly, because claim 4 is supported by the specification, Appellant requests the rejection of claim 4 be reversed.

II. Rejections under 35 U.S.C. § 102(e)

Independent claims 1-6 stand rejected under 35 U.S.C. §102(e). It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections do not satisfy one or more of these requirements, as detailed below.

Claim 1 recites, “a general purpose printer . . .” The Office Action cites perforated strips 214 as teaching this limitation. However, Appellant respectfully submits that perforated strips 214 do not teach a general purpose printer. Accordingly, the item cited by the Examiner fails to disclose a general purpose printer.

Furthermore, claim 1 recites “substantially simultaneously printing a plurality of postage meter stamps on said sheet” (emphasis added). The Office Action fails to cite any art as teaching this limitation. Office Action page 3. Accordingly, because each and every element of a claim must be taught in order for a reference to be anticipatory and the Examiner failed to cite any part of *Block* as teaching this limitation, the Examiner failed to make a *prima facie* case of anticipation against claim 1.

Moreover, in contrast to the recited substantially *simultaneous* printing of meter stamps, *Block* teaches printing labels *consecutively*. For example, *Block* expressly teaches that “following printing of the integrated field of labels for the item to be mailed, the labels

are separated and applied to the item...” Col. 5, lines 22-31. Accordingly, *Block* teaches that address, weight, and class data are provided to the computer for processing, and that the data is then sent to the printer which prints labels associated with a single item to be mailed. Col. 5, line 33 - col. 6, line 12, and FIGURE 4. Thereafter, the labels are separated and applied to that item. Col. 5, lines 23-24. If the user wishes to mail additional packages, the foregoing steps are repeated, thereby clearly and expressly setting forth consecutive label printing requiring sufficient temporal delay thereby precluding an interpretation of substantially simultaneous label printing. As a result, *Block* does not teach this limitation of claim 1.

Further still, claim 1 recites “said postage storage device comprises an expansion card coupled to a host processor based system.” The Examiner cites column 4, lines 30-42 as teaching this limitation. Office Action page 4. However, the cited lines simply discuss maintaining an account balance for the user and do not teach an expansion card coupled to a host processor based system. Moreover, a complete review of *Block* reveals no discussion of an expansion card at all. Accordingly, *Block* does not teach “said postage storage device comprises an expansion card coupled to a host processor based system.” As a result, *Block* fails to teach each and every limitation of claim 1, and Appellant requests the review panel reverse the rejection of record.

Claims 2-6 depend from claim 1 and inherit the limitations therein. Therefore, at least for the reasons set forth above, claims 2-6 are not anticipated by *Block*, and Appellant requests that the review panel reverse the 35 U.S.C. § 102 rejections of record for claims 2-6.

III. Claims 9, 10, 13 and 17-19

Claims 9, 10, 13 and 17-19 are indicated as rejected on the Office Action Summary, however, the Examiner failed to detail the grounds for the claims’ rejections thereby failing to make a *prima facie* case of rejection for the claims. Claims 9, 10, 13 and 17-19 depend from claim 1 and inherit the limitations therein. Therefore, at least for the reasons set forth above, claims 9, 10, 13 and 17-19 are not anticipated by *Block* and do not violate 35 U.S.C. § 112, first paragraph. Thus, Appellant requests that the review panel reverse the undisclosed rejections of claims 9, 10, 13 and 17-19.

IV. Summary

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections in the present application. The required fee for the Notice of Appeal filed with this request is attached. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C1/10106025, from which the undersigned is authorized to draw.

Dated: February 27, 2007

Respectfully submitted,

I hereby certify that this document is being transmitted to the US Patent and Trademark Office via electronic filing.
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